

REMARKS

Claims 1-6 are all the claims pending in the application. Applicants have amended claims 1, 2 and 4-6 in order to remove the rejection under Section 112, second paragraph. This amendment places claims 2, 5 and 6 into condition for allowance and places claims 1 and 4 into better form for appeal.

Claim Rejections - 35 USC § 112

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. This rejection is traversed for at least the following reasons.

The Examiner continues to observe that Applicant claims states that the device is bent "like a bow." The Examiner asserts that "it is unclear to what the applicant is trying to claim as the language like a bow is vague as there are many kinds of bows." In the response to arguments, the Examiner states that "there are many types of bows such as bows to wrap a gift." The Examiner suggests the addition of specific structural language.

Applicants have amended the claim to now state that the likeness is to a "long bow," a structure that is well known. The term is so well known that Wikipedia describes it as a type of bow that is tall, not significantly recurved and has relatively narrow limbs, and the long slightly curved structure immediately comes to mind. This description clearly matches the illustration in Fig. 1b of the present application. Thus, no new matter is added.

Additional Claim Limitations Define the "Bow"

In the event that the Examiner refuses entry, Applicant reiterates for the sake of appeal that the term "bow" as used in the claim cannot be confused with a gift wrap bow, as the structure also has the express characteristic as being a bow "in a longitudinal direction" and forming "a slender plate."

Interpretation in Light of the Specification

Applicant again respectfully submits that the claims are to be interpreted in light of the specification. The original specification expressly states at page 6 that the invention is “A portable shoehorn 1 (refer to FIGS. 1A and 1B) is a shoehorn obtained by bending a plate member, which has been bend in a breadth direction thereof, in a longitudinal direction thereof approximately lien [*sic* “like”]a bow to form a slender plate shape...” Also, at page 9, the original application states “Then, when the portable shoehorn 1 carried in a folded state is used, any one of the backscratcher 2 and the shoehorn portion 1b of the shoehorn is rotated for opening such that both the backscratcher 2 and the shoehorn portion 1b are made into a state like a slender plate, as shown in FIG. 1, which is bent approximately like a bow.”

Interpretation in Light of the Figures

In addition to the specification and claims, which define the bow shape as forming “a slender plate shape,” Figure 1(b) makes this textual description absolutely clear.

The Examiner Is Not Confused

Applicants respectfully note that the Examiner is not confused by the term “bow,” as he applies the prior art against this structure without reservation.

The term “bow” approximating a “plate shape” as used in the claims is abundantly clear and the rejection should be withdrawn.

Claim Rejections - 35 USC § 103

Claims 1 and 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wedermeyer (US D208,894) in view of Fong (US 5,185,902. This rejection is traversed for at least the following reasons.

The Examiner repeats the basis for rejection. In response to Applicant’s arguments, the Examiner states “The applicant argues the back scratcher does not have any removable parts.

The examiner disagrees, as stated in the prior office action the Wedermeyer teaches holding pins that would be capable of being removed. The elastic handle of Wedermeyer can function as the backscratcher as stated in the prior office action.” The Examiner fails to consider the following key deficiencies in Wedermeyer, which would be emphasized on appeal.

No Elastic Body for Patting a Human Body

The elastic body, as claimed and disclosed clearly in the specification (at least pages 9 and 10) and drawings, is for “patting a human body” so that stress is removed. The strap in Wedermeyer cannot “pat” a human body, as it is simply a flexible strap. There is no basis for concluding that the strap can provide any form of relief. The Examiner’s assertion is unfounded in fact and contrary to logic.

No Removeable Elastic Body

The Examiner asserts that combined back scratcher and shoe horn has “an elastic body (the handle) removable via the holding pins.” This is not taught or inherent.

The pins are permanent. The pins hold the flexible strap, and ONLY the strap. Nothing teaches or suggests that (1) the pins are removeable, (2) that there is any advantage to making them removeable, or (3) or that one skilled in the art would want them removeable. even that the pins hold y are removeable. Indeed, as subsequently noted, the strap is useful to keep the shoehorn end in a users hand when a back is being scratched, so that it is not dropped. There is no reason to move the strap to the backcrachter end since it would be of no advantage to the use as a shoehorn.

No Mounting to Both Backscratcher AND Shoehorn

As disclosed and claimed, the elastic body for patting the human body is mountable to both the backscratcher and the shoehorn, so that it can function as a patting element at either end.

As previously noted, there is no reason to mount the strap at both ends of the Wedermeyer structure.

No Folding Handle

The Examiner does correctly state that Wedermeyer does not teach the handle portion being capable of folding.

In sum, Wedermeyer is merely one long straight shaft shaped at opposite ends with a back scratcher and a shoe horn, that is NOT foldable. Further, there is NO elastic body for patting a user, especially one that is removeably mountable at either end and is removeable.

Fong

In the response to arguments, the Examiner did not address Fong, which is cited to remedy the deficiencies of Wedermeyer. Since the Examiner appears not to have considered the arguments regarding Fong, or agrees with the Applicant's position, Applicants will reiterate.

First, there is no teaching of removeability in either reference. Thus, this expressly claimed feature is not in the prior art.

Second, the brush in Fong does not have a shape "in a longitudinal direction thereof approximately like a bow to form a slender plate shape," as claimed.

Third, there is no "elastic body for patting a human body is constituted so as to be removeably mounted to a portion of the backscratcher and a shoehorn portion of the shoehorn." Indeed, the Examiner does not even mention this limitation, and perhaps it has been overlooked in the analysis.

Allowable Subject Matter

Applicants appreciate the Examiner's indication that claims 2 and 5-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph. Applicants have amended the claims to state a clearer structural limitation to the bow.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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